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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715,009	11/20/2000	Keiichi Yamauchi	Q61858	7924

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06/29/2005

SUGHRUE, MION, ZINN, MACPEAK & SEAS
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037

EXAMINER

CHU, KIM KWOK

ART UNIT	PAPER NUMBER
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2653

DATE MAILED: 06/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/715,009

Applicant(s)

YAMAUCHI, KEIICHI

Examiner

Kim-Kwok CHU

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on 1/31/2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-9, 11-14, 21-25, 27 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9, 25, 36 and 37 is/are allowed.
- 6) ☒ Claim(s) 6-8, 11-14, 21-24, 27 and 31-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Response to Remarks

1. Applicant's Remarks filed on January 31, 2005 have been fully considered.

(a) With respect to Claims 6, 7, 22, 23, 27 and 31-35, Applicant states that the cited prior art of Nagashima fails to teach or suggest "a second information recording medium in which random access is possible" (page 17 of the Remarks, last three lines). Accordingly, the prior art of Nagashima's second recording medium 2 can be randomly accessed. First, the recording medium 2 is a magneto-optical disc where data can be reproduced/accessed. Second, the data stored in the magneto-optical disc 2 can be accessed as randomly/desired (column 4, lines 32-34). In other words, during the recording mode, the tracks in the magneto-optical disc 2 can be selected to store data. When the disc 2 is in a playback/read mode, any data file stored in the tracks can be selected as desired.

(b) With respect to Claims 11 and 27, Applicant states that the cited prior art of Nagashima does not teach "recording audio information to a second recording medium at the same time as map information is reproduced from the second recording medium" (page 19 of the Remarks, lines 4 and 5). Accordingly, map information such as sync information and sector addresses stored in the disc 2 needs to be read during a recording mode so that data can be recorded at the proper speed and locations.

(c) With respect to Claims 12-14, Applicant states that the prior art of Nagashima does not teach "audio information being reproduced and recorded on the same record medium at the same time" (page 19 of the Remarks, lines 12 and 13). Accordingly, Nagashima teaches the audio can be output from the decoder 21 while it is recorded (Fig. 1). In fact, this feature is commonly used in the practice of burning a music CD with a PC computer. In such case, the recorded data is output to the speaker during the burning process. Other common uses of the above feature, for example, can be found in a multimedia on demand application.

(d) With respect to Claim 21, Applicant states that the record mediums of Belknap would both be used in the storage nodes (160, 180) and any audio information would follow as indicated by the arrow, not between the alleged record mediums (page 20 of the Remarks, lines 9-12). Accordingly, Belknap teaches a first information record medium 160, 162/180 where multimedia is stored and then upon a request, the multimedia data is distributed through a media streamer 10 to a user's second recording medium 45 (Fig. 1 and 1C).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

3. Claims 6, 7, 11, 27 and 31-35 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 6 and 7. For example, Nagashima teaches the following:

(a) as in claim 6, a first reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1; the first reproducing device 33 is the playback unit; column 3, lines 40-42);

(b) as in claim 6, a recording device 3 for recording the reproduced audio information into a second information record medium 2 in which random access is possible (Fig. 1; column 4, lines 30-32; tracks/data in a magneto-optical disc can be selected as desired);

(c) as in claim 6, a second reproducing device 3 for reproducing the audio information recorded in the second information record medium 2 (Fig. 1; column 4, lines 41-43);

(d) as in claim 6, a controlling device 7 for setting a recording speed when recording the audio information into the second information record medium 2 and a reproducing speed when reproducing the audio information from the second information record medium 2 (Fig. 1; device 7 sets the operating mode such as a high speed dubbing mode and audio playback mode);

(e) as in claim 6, controlling the recording speed is equal to or higher than the reproducing speed (Fig. 1; recording data requires less time than playback the data);

(f) as in claim 6, controlling the second reproducing device 3 and the recording 3 device so as to perform reproducing the recorded audio information from the second information record medium 2 at the set reproducing speed in parallel to recording the audio information into the second information record medium 2 at the set recording speed (Fig. 1; column 7, lines 45-59);

(g) as in claim 6, the controlling device 7 controls the recording device 3 so as to record information indicative of a portion of the audio information (Fig. 2; linking sectors, headers and sync signals are recorded; column 9, 26-34);

(h) as in claim 6, the information indicative of a portion of the audio information is being recorded at a time of stopping

a recording operation of recording the audio information into the second information record medium 2, into the second information record medium 2 and then stop the recording operation, when the recording operation is to be stopped in a middle of recording the audio information into the second information record medium 2 (Fig. 2; linking sections are recorded when the recording is stopped in the middle of recording/burst mode recording; column 1, lines 25-27); and

(i) as in claim 7, the controlling device 7 controls the recording device so as to output stop information indicative of stopping the recording operation when the recording operation is to be stopped in the middle (Figs. 1 and 2; user input 8 sends control signals such as positions of start/stop; column 7, lines 1-10; burst mode recording, column 1, lines 25-27).

4. Claims 11 and 27 have limitations similar to those treated in the above rejection, and are met by the reference as discussed above. Claims 11 and 27 however also recite the following limitations which are also taught by the prior art:

(a) as in claims 11 and 27, the second information record medium 2 having map information to control a navigation function is further recorded (Figs. 2 and 3, subcode information such as header and linking sectors are map information of the medium 2);

(b) as in claims 11 and 27, a navigation device 8, 9 for controlling the navigation (editing, dubbing) function by using the map information (Fig. 1; user key and display is used for editing the recording operation); and

(c) as in claims 11 and 27, the second reproducing device reproduce the map information during the recording of the audio information by the recording device (map information such as sync information and sector addresses stored in the disc 2 needed to be read during a recording mode so that data can be recorded in proper speed and locations).

5. Claims 31-35 have limitations similar to those treated in the above rejection, and are met by the reference as discussed above. Claims 31-35 however also recite the following limitation which is also taught by the prior art:

(a) as in claims 31-35, controlling the first reproducing device 33 reproducing a recorded non-compressed information faster than normal speed (Fig. 1; linking sectors and headers are non-compressed information which are reproduced by device 41 faster than normal speed during high speed dubbing); and

(b) as in claims 31-35, the reproducing a recorded non-compressed information is in parallel to recording a compressed information which are converted from the non-compressed information by a compressing device 13 (During the copying operation, the non-compressed data attached to the audio information becomes a new compress-information; ADPCM is the compressed means).

6. Claims 12-14 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 12-14. For example, Nagashima teaches the following:

(a) as in claim 12, a first reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1; disc 32 is read; abstract, line 3);

(b) as in claim 12, a recording device 3 for recording the reproduced audio information into a second information record medium 2 (Fig. 1; disc 2 is written on, abstract, line 7);

(c) as in claim 12, a second reproducing device 3 for reproducing the audio information recorded in the second information record medium 2 (Fig. 1; recording device is also a reproducing device as it has ADPCM decoder and output 26);

(d) as in claim 12, a controlling device 7 for controlling the recording device to record the audio information (Fig. 1);

(e) as in claim 12, the audio information is reproduced from the first information record medium 32 by the first reproducing device 33, when the audio information is outputted as a sound and also controlling the second reproducing device 3 to reproduce and output the audio information as the sound (Fig. 1; both reproducing devices 33 and 3 output audio);

(f) as in claim 12, the audio information is reproduced from the second information record medium and recorded on the second information medium at the same time (Fig. 1; encoded data can be read from the audio output 26 after decoder 21 while the data is being recorded);

(g) as in claim 13, a converting device for converting a form of the audio information, wherein the controlling device controls the converting device and the recording device to convert the form of the audio information and then record the audio information when recording the audio information reproduced by the first reproducing device into the second information record medium (Fig. 1);

(h) as in claim 14, a compressing device 13 for compressing the audio information; and an expanding device 23 for expanding the compressed audio information (Fig. 1);

(i) as in claim 14, the controlling device 7 controls the compressing device 13 and the recording device 3 to compress the audio information and then record the compressed audio information when recording the audio information, which is reproduced by the first reproducing device 33, into the second information record medium 2 (Fig. 1); and

(i) as in claim 14, the controlling device 7 controls the second reproducing device 3 and the expanding device 23 to reproduce the compressed audio information, expand the reproduced

audio information and then output the expanded audio information as a sound (Fig. 1).

7. Claim 21 is rejected under 35 U.S.C. § 102(b) as being anticipated by Belknap et al. (U.S. Patent 5,586,264).

Belknap teaches an information recording and reproducing apparatus having all of the elements and means as recited in claim 21. For example, Belknap teaches the following:

(a) as in claim 21, a reproducing device 160, 162 for reproducing audio information from a first information record medium (VHS tape), in which the audio information is recorded (Fig. 12; column 1, lines 37-40; movies includes audio files are stored in the first record medium such as a VHS tape);

(b) as in claim 21, a recording device 16 (user recording means) for recording the reproduced audio information into a second information record medium 45 (Figs. 1 and 1C; column 1, lines 63-65; the second recording medium is a DVI tape or DVD disc with MPEG format);

(c) as in claim 21, a second reproducing device 16 for reproducing the audio information recorded in the second information record medium 45 (Fig. 1C; column 7, lines 53-63);

(d) as in claim 21, a controlling device 44, 46, 48 (user's computer system) for controlling the reproducing device and the recording device so as to perform recording the reproduced audio

information into the second information recording medium 45 in parallel (multimedia on demand) to reproducing the audio information from the first information recording medium 160, 162 (Figs. 1 and 12; audio is reproduced while the user is recording of the audio to the DVI or MPEG disc; user watch multimedia while it is being recorded);

(e) as in claim 21, the audio information is recorded in the first information record medium (tape) in a compressed state based on a first compressing method (VHS tape is in NTSC format);

(f) as in claim 21, the recording device records the audio information in a compressed state based on a second compressing method, which is different from the first compressing method, into the second information record medium (DVI's audio is compressed in ADPCM and DVD's audio is compressed in MPEG format); and

(g) the audio information is reproduced from the second information 45 and recorded on the second information recording medium at the same time (Figs. 1 and 12; audio is reproduced while the user is recording of the audio to the DVI or MPEG disc; user watch multimedia while it is being recorded).

8. Claims 22 and 23 are rejected under 35 U.S.C. § 102(b) as being anticipated by Nagashima et al. (U.S. Patent 5,963,521).

Nagashima teaches an information recording and reproducing apparatus having all of the elements and means as recited in claims 22 and 23. For example, Nagashima teaches the following:

(a) as in claim 22, a reproducing device 33 for reproducing audio information from a first information record medium 32, in which the audio information is recorded (Fig. 1; the first reproducing device 33 is the playback unit; column 3, lines 40-42);

(b) as in claim 22, a recording device 3 for recording the reproduced audio information into a second information record medium 2 in which random access is possible (Fig. 1; column 4, lines 30-32; tracks/data in a magneto-optical disc can be selected as desired);

(c) as in claim 22, a controlling device 7 for controlling the reproducing device 33 and the recording device 3 so as to perform recording the reproduced audio information into the second information record medium 2 in parallel to reproducing the audio information from the first information record medium 32 (Fig. 1);

(d) as in claim 22, the controlling device 7 controls the

recording device so as to record information indicative of a portion of the audio information (Fig. 2; linking sectors, headers and sync signals are recorded; column 9, 26-34);

(e) as in claim 22, the indicative of a portion of the audio information is being recorded at a time of stopping a recording operation of recording the audio information into the second information record medium 2, into the second information record medium and then stop the recording operation, when the recording operation is to be stopped in a middle of recording the audio information into the second information record medium (Fig. 2; linking sections are recorded when the recording is stopped in the middle of recording/burst mode recording; column 1, lines 25-27); and

(f) as in claim 23, the controlling device 7 controls the recording device 3 so as to output stop information indicative of stopping the recording operation when the recording operation is to be stopped in the middle Figs. 1 and 2; user input 8 sends control signals such as positions of start/stop; column 7, lines 1-10; burst mode recording, column 1, lines 25-27).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 8 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagashima et al. (U.S. Patent 5,963,521) in view of Hetzler (U.S. Patent 5,682,273).

Nagashima teaches an optical data storage system for writing and/or reading information with respect to an optical storage medium very similar to the instant invention. For example, Nagashima teaches the following:

(a) as in claims 8 and 24, the recording operation is stopped by stopping a main electric power supplying device for supplying an electric power to the information recording and reproducing apparatus in a normal operation (power switch is an inherent feature to control the supply of electricity).

However, Nagashima does not teach the following:

(a) as in claim 8, a sub electric power supplying device for supplying an electric power to the information recording and

reproducing apparatus after the main electric power supplying device is stopped.

Hetzler teaches a data storage apparatus having a power saving mode or idle mode as a sub electric power supply to keep a controller responsive (table 1, column 5).

A system under idle mode saves power and still is responsive to any requested operation. For example, Hetzler discloses ~~FIG. 1~~ a stand-by power mode when the disc is in a parking mode. Similarly, when Nagashima's recording/reproducing operations require it to be woke up by the input 8 and display 9 after its main power is turned off, it would have been obvious to one of ordinary skill in the art to use a sub electric power (stand-by power) such as Hetzler's, because the sub electric power keeps the input device responsive even when the main power is turned off.

Allowable Subject Matter

11. Claims 9, 25, 36 and 37 are allowable over prior art.

12. The following is an Examiner's statement of reasons for the indication of allowable subject matter:

As in claim 9, the prior art of record fails to teach or fairly suggest a compressing device for reproducing the recorded audio information from the second information record medium, compressing the reproduced audio information, and recording again the compressed reproduced audio information into the second information record medium.

As in claim 25, the prior art of record fails to teach or fairly suggest a compressing device for judging the audio information which is recorded in a non-compressed state from among the audio information recorded in the second information record medium, reproducing the judged audio information in the non-compressed state from the second information record medium, compressing the reproduced audio information by applying a predetermined compressing process onto the reproduced audio information, and recording again the compressed audio information into the second information record medium.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Henderson et al. (5,719,983) is pertinent because Henderson teaches a multimedia transferring and copying system.

Vishlitzky et al. (5,737,747) is pertinent because Vishlitzky teaches a multimedia transferring and copying system.

14. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action

15. Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

(571) 273-8300 (for formal communications intended for entry. Or:

(571) 273-7585, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Any inquiry of a general nature or relating to the status of this application should be directed USPTO Contact Center (703) 308-4357; Electronic Business Center (703) 305-3028.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

Kim-Kwok CHU

bc 6/24/05
Examiner AU2653
June 24, 2005

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